

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

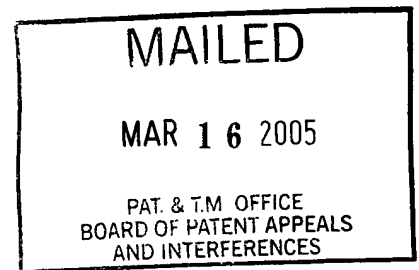
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HYUNG-SIK CHOI

Appeal No. 2005-0069
Application No. 09/507,093

ON BRIEF



Before BARRETT, CRAWFORD, and MACDONALD, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 3, 5, which are all of the claims pending in this application. Claims 4 and 6 to 12 have been canceled.

The appellant's invention relates to an advertising method using software products in which an advertisement is included in the program of a software product

(specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The References

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Petrecca et al. (Petrecca)	5,781,894	Jul. 14, 1998
Horstmann	6,285,985	Sep. 4, 2001 (filed Apr. 3, 1998)

The Rejections

Claims 1 to 3 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Horstmann in view of Petrecca.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 19, mailed February 24, 2004) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 17, filed December 4, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The examiner has rejected the claims 1 to 3 and 5 under 35 U.S.C. § 103 as being unpatentable over Horstmann in view of Petrecca.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain

Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

The examiner relies on Horstmann for teaching or suggesting the elements of claim 1 with the exception that Horstmann does not disclose inserting an advertisement into at least a portion of a software program without connecting to the Internet. The examiner relies on Petrecca for teaching inserting advertisement into software during the making of the software without connecting to the Internet. The examiner concludes:

It would have been obvious to one having ordinary skill in the art at the time of the invention to have the software program with the inserted advertisement operable without connecting to the Internet as in Petrecca in the system of Horstmann since this would have allowed sponsors to reach more customers by providing another software distribution channel (disks) [answer at page 4].

The appellant argues that Horstmann does not disclose or suggest that the software program resumes only when the inserted advertisement displayed on the screen is clicked on as is recited in claim 1 from which claims 2, 3 and 5 depend. The examiner reasons that:

While Horstmann does not specifically state that the software program resumes only when the sponsored advertisement is clicked on, it would have been obvious to one having ordinary skill in the art to have allowed the program to resume by clicking on the advertisement since this would have been adopted for the intended use of allowing the user to regain control over the use of the application and increasing user satisfaction with the subsidized software while still monitoring that ads are viewed by the user for the sponsors [answer at pages 3 to 4].

As the examiner has failed to direct our attention to something in the references themselves that suggests modifying the Horstmann reference so that the software is continued only after the advertisement is clicked on, a prima facie case of obviousness has not been established. Therefore, we will not sustain the rejection.

REVERSED

Allen R. MacDonald
ALLEN R. MACDONALD
Administrative Patent Judge

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